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PRE-APPEAL BRIEF REQUEST FOR REVIEW

Docket Number (Optional)	
1163-0340P	

Application Number	Filed
09/857,491-Conf #5202	June 6, 2001
First Named Inventor	
Toyokazu SUGAI	
Art Unit	**Examiner**
2623	S. A. Chowdhury

Applicant requests review of the final rejection in the above-identified application. No amendments are being filed with this request.

This request is being filed with a notice of appeal.

The review is requested for the reason(s) stated on the attached sheet(s)
Note: No more than five (5) pages may be provided.

I am the

- [ ] applicant /inventor
- [ ] assignee of record of the entire interest.
  See 37 CFR 3.71. Statement under 37 CFR 3.73(b) is enclosed. (Form PTO/SB/96)
- [x] attorney or agent of record
  Registration number 29,680
- [ ] attorney or agent acting under 37 CFR 1.34
  Registration number if acting under 37 CFR 1.34 _____

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September 4, 2007
Date

NOTE: Signatures of all the inventors or assignees of record of the entire interest or their representative(s) are required. Submit multiple forms if more than one signature is required, see below*

- [ ] *Total of 1 forms are submitted

Docket No.: 1163-0340P
(PATENT)

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

In re Patent Application of:
Toyokazu SUGAI

Application No.: 09/857,491 Confirmation No.: 5202

Filed: June 6, 2001 Art Unit: 2623

For: DEVICE FOR SENDING OUT DATA IN WHICH ASSOCIATED DATA IS MULIPLEXED WITH MAIN DATA Examiner: S. A. Chowdhury

REQUEST FOR PRE-APPEAL BRIEF CONFERENCE

MS AF
Commissioner for Patents
P O Box 1450
Alexandria, VA 22313-1450

Sir:

INTRODUCTORY COMMENTS

Applicants request review of the final rejection in the above-identified application. No amendments are being filed with this request.

This request is being filed concurrently with a Notice of Appeal.

The review is being requested for the reasons set forth on the attached sheets.

As detailed below, the Examiner has made clear errors in fact, and has failed to establish a *prima facie* prior art rejection due to clearly missing teachings from the applied art and the omission of an essential element.

I. The Examiner Has Failed To Establish Prima Facie Obviousness By Failing To Provide References That Teach Or Suggest All Of The Claim Elements

Claims 1, 8-10, and 14-21 are rejected under 35 U.S.C. § 103(a) as being unpatentable over U.S. Patent No. 6,505,347 to Kaneko et al. ("Kaneko") in view of U.S. Patent No. 6,658,661 to Arsenault et al. ("Arsenault"). Applicants respectfully request the Panel to withdraw this rejection because Kaneko and Arsenault, taken separately or in combination, fail to teach or suggest each claimed feature.

A. Presently Claimed Features

Independent claim 1 recites a device for producing one or more tables based on electronic program guide information ("associated data"), which is associated with a broadcast program ("main data"). According to claim 1, after being transformed into a bit stream, the associated data is sent out according to two criteria:

(1) the associated data is sent out according to a bit rate ("sending-out rate") equal to or lower than a prescribed upper limit, and

(2) the associated data is sent out at a frequency ("sending-out frequency") equal to or higher than a specific sending-out frequency for at least one type of table

Claim 1 further recites that, if the amount of information in the associated information exceeds the amount necessary for achieving both criteria (1) and (2) above, the amount of information in the associated data is decreased to be less than or equal to the necessary amount.

B. Deficiencies Of Kaneko

As such, claim 1 requires performing a conditional analysis by determining whether the amount of information in the associated data exceeds an amount necessary to a sending out a specific sending-out frequency and, if such is the case, decreasing the amount of information in the associated information to be less than or equal to the necessary amount. In page 4 of the Final Rejection issued May 3, 2007 ("Final Rejection"), the Examiner expressly admits that Kaneko fails to disclose this feature. However, the Examiner asserts that Arsenault teaches this feature, citing col. 7, lines 15-53. Applicants respectfully disagree.

C. Synopsis Of Arsenault

Arsenault describes a satellite television system in which each broadcast channel transmits electronic program guide (EPG) data on multiple carousels in parallel (col. 7, lines 23-30; col. 9, lines 6-11). Each carousel in Arsenault corresponds to a particular time span relative to the current time. For example, the first carousel corresponds to programming for the next 6 hours starting from the current time, the second carousel corresponds to programming beginning 6 hours after the current time and

ending 24 hours after the current time, and so forth (col. 7, lines 40-49). In Arsenault, the carousel of an earlier time period (e.g., the next 0-6 hours) transmits its EPG objects at a higher frequency than the carousel of a later time period (e.g., 6-24 hours from the current time) (col. 7, lines 35-40).

Further, Arsenault teaches that the home receiver, i.e., integrated receiver/decoder unit (IRD), populates its local programming guide based on each carousel's information. At a particular time, the IRD may not need to acquire every carousel to populate its programming guide. For example, the IRD may only want to acquire a subset of carousels based on RAM constraints, or the IRD may only need to acquire data from a particular carousel because of a previous interruption (loss of signal, transponder change, etc.) during the read cycle for that carousel (col. 7, lines 59-64; col. 8, line 62 - col. 9, line 5). Thus, while acquiring the carousel data, Arsenault's IRD sets a local bit mask identifying which carousels are to be acquired. Since the transmitted EPG objects contains bit masks identifying the carousels to which they belongs, the IRD performs a logical operation on the local bit mask and each incoming EPG object's bit mask to determine which EPG objects to save (col. 9, lines 6-23).

D. Arsenault Fails To Remedy Kaneko's Deficiencies

In this rejection, Applicants presume that the Examiner relies on Arsenault's EPG objects for the claimed "associated data," and on one of the frequencies assigned to Arsenault's EPG carousels for the claimed "specific sending-out frequency for at least one type of table" (even though the Examiner's rejection fails to explicitly state this). However, the Examiner's rejection fails to provide any guidance as to how Arsenault can be interpreted to teach determining whether the amount of information in the EPG objects is too much to achieve any particular criterion, let alone achieving an assigned carousel frequency (see Final Rejection at page 4). Further, Examiner's rejection fails to point out any particular teaching in Arsenault of decreasing the amount of information produced for the EPG objects.

Applicants respectfully submit there is no teaching or suggestion in Arsenault of determining whether there is too much information in the EPG objects to achieve any assigned sending-out frequency for the carousels. The Examiner has failed to point out any part of Arsenault suggesting that Arsenault's transmission station performs any conditional analysis on the amount of information produced for the EPG objects. As such, Arsenault cannot be relied on to teach or suggest determining whether the amount of information in the associated data exceeds an amount necessary to achieve a specific sending-out frequency for a particular type of table, as claimed. Furthermore, Applicants can find no teaching or suggestion in Arsenault that the transmitting device decreases the amount of information in any of the EPG objects for any of the carousels for any reason.

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In fact, Arsenault does not provide any specific disclosure as to the internal operation of the device that transmits the carousel data. Instead, Arsenault's invention is only concerned with the output of the transmission station (i.e., format and transmission frequency of EPG objects), and the internal operation of the device (IRD) receiving such objects.

Therefore, Applicants submit that Arsenault fails to teach or suggest determining whether the amount of information in the associated data exceeds an amount necessary to a sending out a specific sending-out frequency and, if necessary, decreasing the amount of information in the associated information to be less than or equal to the necessary amount, as required by independent claim 1. Since Kaneko similar fails to teach or suggest these features, as admitted by the Examiner, Applicants respectfully submit that the Examiner has failed to establish a *prima facie* case of obviousness under § 103 with respect to independent claim 1. Accordingly, the Panel is respectfully requested to withdraw this rejection.

II. The Examiner Has Failed To Provide Rational Underpinning To Combine References

Further, Applicants respectfully submit that the Examiner has omitted an essential element for establishing a *prima facie* case under § 103. Specifically, in *KSR Int'l v. Teleflex Inc.*, 82 USPQ2d 1385, 1396 (2007), the Supreme Court cited with approval the following statement from *In re Kahn*, 441 F. 3d 977, 988 (CA Fed. 2006),

> "[R]ejections on obviousness grounds cannot be sustained by mere conclusory statements; instead, there must be some articulated reasoning with some rational underpinning to support the legal conclusion of obviousness."

Applicants respectfully submit that the Examiner has failed to articulate any reason that would prompt one of ordinary skill to combine Kaneko and Arsenault as proposed. The Examiner merely asserts it would have been obvious to modify Kaneko in view of Arsenault "in order for the receiver to acquire information in an efficient manner" (Final Rejection at paragraph bridging pp. 4-5). This is merely a conclusory statement without any rational underpinning. The Examiner has not pointed out any teaching in Kaneko or Arsenault, provided any extrinsic evidence, or articulated any reasoning to show that modifying Kaneko's transmitter to produce carousel data would increase receiver efficiency.

Since the Examiner has failed to provide the requisite rational underpinning for combining Kaneko and Arsenault, Applicants respectfully submit that the Examiner has omitted an essential element to establish a *prima facie* case under § 103. Thus, this rejection should be withdrawn.

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III. The Finality Of The Current Office Action is Improper

Applicants respectfully submit that the Examiner made clear error in making the Kaneko/Arsenault rejection final even though it constitutes a new ground of rejection.

In the non-final Office Action issued on December 12, 2006, claims 1, 8-10, and 14-21 were rejected under 35 U.S.C. § 102 as being anticipated by Kaneko. However, in response to the Amendment filed March 12, 2007 ("previous Amendment"), the Examiner withdrew the § 102 rejection in favor of the current § 103 rejection based on Kaneko and Arsenault. The Examiner asserted that the new ground of rejection was necessitated by Applicants' amendment (Final Rejection at page 10, 1st paragraph). Applicants respectfully disagree.

In the previous Amendment, the following clarifying amendments were made to claim 1. First, line 11 was amended to clarify that the data sending-out device makes the determination whether the amount of information in the associated data exceeds the necessary amount. Also, line 16 was amended to replace "associated data" to --the associated data--. Applicants submit that both clarifying amendments are consistent with the interpretation of claim 1 applied by the Examiner in the previous Office Actions, and did not substantively change the claim scope in a manner necessitating the new ground of rejection.

Applicants submit the reason for the new ground of rejection is that the Examiner's SPE, Christopher Grant, was persuaded during the interview of January 17, 2007 that Kaneko failed to teach all the features of claim 1 in its then pending form. Specifically, SPE Grant agreed that Kaneko did not teach decreasing the amount of information in the associated data when it exceeds the amount necessary to achieve a specific frequency for at least one type of table.

Even in the Final Rejection, the Examiner stated that she brought in Arsenault because she agreed that "Kaneko fails to teach achieving a sending-out frequency for at least one type of table that is greater than or equal to a specific frequency" (page 2, 1st paragraph). Based on this statement, it is clear that the above clarifying amendments were not instrumental in the decision to apply the new ground of rejection.

Accordingly, Applicants submit that the Examiner has committed clear error in making this action final since the new ground of rejection in the Final Rejection was not necessitated by Applicants' amendment. As such, if the Panel decides not to withdraw this rejection, Applicants respectfully submit that the finality of this rejection should be withdrawn and a new non-final Office Action should be issued.

IV. Conclusion

In view of the foregoing, the Examiner has committed clear errors and omitted essential elements with respect to the outstanding § 103 rejection of claim 1. Accordingly, this rejection should be withdrawn.

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